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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,618	12/11/2003	Charles Howard Caplan	KMC / 275DV	8504
7590	04/13/2004		EXAMINER	
WOOD, HERRON & EVANS, L.L.P. 2700 Carew Tower 441 Vine St. Cincinnati, OH 45202			NGUYEN, THONG Q	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/733,618	CAPLAN ET AL.
	Examiner	Art Unit
	Thong Q Nguyen	2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 December 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Drawings

1. The drawings contain seventeen sheets of figures 1a-34 were received on 12/11/2003. These drawings are objected by the Examiner for the following reasons.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: The references "12" and "259" shown in figure 2; the reference "330" shown in figure 3A; and the reference "321" and "352" shown in figure 3B. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: The reference "20" stated in the specification in page 7, line 10. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to because the use of references in the drawings is confusing. In particular, in figures 8A the references "18B" and "18C" should be changed to --8B-- and --8C--, respectively because the details shown in circles of figure 8A are shown in large scale in figures 8B and 8C, and the application does not have

any figures labeled as "18B" and "18C". Second, in figure 32, it is unclear the boundary of the angle alpha. Applicant should add an arrow on the right side of the figure to define the angle alpha. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
6. The disclosure is objected to because of the following informalities: a) In page 1, applicant should update the status of the application, serial number 09/761,086 which is now U.S. Patent No. 6,704,142; b) In page 10: lines 14 and 20, the reference "340" is used to refer to two different items, i.e., internal threads and O-ring. The examiner is of opinion that the reference "340" on line 20 should be changed to -330—as shown in figure 3A; c) Page 13: line 3, "angle B" should be changed to –angle beta--; d) In each of Tables I-XII, the words "R3" and "R4" which label the radius of the lens element III should be changed to -R4—and -R5--, respectively. The reason of that suggestion is that the word "R3" is used to refer to the radius of the lens surface facing the object of the lens element II; e) In each of Tables X-XII, it is unclear how applicant provide only one value for the lens surfaces of the element I and the element II. Applicant should note that each lens element has two lens surfaces and applicant has provided the value

of each lens surfaces of the lens elements as can be seen in each Tables I-IX; f) In each Tables XIII-XXIV, the order of the lens surfaces "R7" and "R6" should be reversed because the lens surface "R6" must be arranged ahead the lens surface "R7". There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

First, thee device as claimed is rejected under 35 USC 112, first paragraph because the specification fails to provide an system having two-element eyepiece lens, three-element objective lens and two-element prism wherein the magnification is varied in the range of approximately 3.3 to approximately 4.8. The invention as taught in the specification discloses that the change in magnification of the device is made by a change in different objective lens. See specification in pages 3 and 7, for example while maintaining the prism and the eyepiece lens. However, in all of the embodiments provided in Tables XIII-XXIV,

applicant has provided a single objective lens with specific data characteristics.

As a result, the device as provided in Tables XIII-XXIV has a change in working distance but not in magnification.

Second, the device as claimed is rejected under 35 USC 112, first paragraph because the structure of the device as claimed is not supported in the specification and the drawings. As stated in the specification and the drawings, in particular, figures 3A-B, the objective lens is supported by the lens barrel (108) and the eyepiece lens is supported by the lens barrel (110) which lens barrel (110) is positioned near the spectacles (102). The eyepiece lens system as described is the one supports more lens elements than the objective lens system. As a result, the recitation relating to the lens structure of the device as claimed on the data features and the description provided on last eight lines of the claims is not supported by the specification.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1 is rejected under 35 USC 112, second paragraph for the following reason. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and

bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation thereof "the loupe having a magnification in the range of approximately 3.3 to approximately 4.8" (lines 8-9), and the claim also recites a specific data features of the objective lens having lens elements III-VI which is the narrower statement of the range/limitation.

b) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiency thereof.

Claim Objections

11. Claim 1 is objected to because of the following informalities. Appropriate correction is required.

On line 10, the term "S1" should be placed in a parenthesis.

On line 12, "the said lenses" should be changed to –said lenses (or the lenses)--.

On line 16, the lens surface "R3" in the phrase "R3 = 12.45" of lens element II should be changed to -R2— because this lens surface is a cemented lens interface with the lens surface of the lens element I.

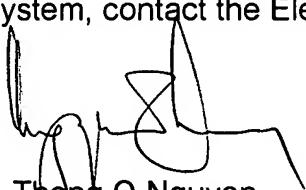
On line 21, the order of the lens surfaces "R7" and "R6" should be reversed because the lens surface "R6" must be arranged ahead the lens surface "R7".

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q Nguyen
Primary Examiner
Art Unit 2872
